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PATENT

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8/23/04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: N. Osborn et al.

Serial: 09/773,061

Group Art Unit: 2682

Filed: January 30, 2001

Examiner: Yuwen Pan

For: METHOD AND APPARATUS FOR SELECTIVE AND
AUTOMATIC TWO-WAY BEAMING OF RELATED
INFORMATION TO AND FROM PERSONAL INFORMATION
MANAGEMENT SYSTEMS

RECEIVED

REMARKS

JAN 28 2004

Honorable Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Technology Center 2600

Dear Sir:

In response to the Office Action mailed November 19, 2003 in the above
captioned case, Applicants respectfully request the Examiner to consider the
following remarks.

REMARKS

Claims remaining in the present patent application are Claims 1 – 20.

35 U.S.C. § 102 (e) Rejections

Claims 1-12, 14-18 and 20 are rejected under 35 U.S.C. § 102 (e) as being anticipated by Hild et al. (US# 6,532,368 B1), (“Hild”). Applicants have reviewed the cited reference and respectfully assert that embodiments of the present invention as recited in Claims 1-12, 14-18 and 20 are not anticipated or rendered obvious by Hild.

Referring to Independent Claims 1, 8 and 14, Applicants respectfully assert that Hild does not teach, disclose or suggest the claim limitation of “in response to step b), said electronic device automatically displaying a message indicating a user selection” as recited by Claims 1, 8 and 14.

With reference to this element of Claims 1, 8 and 14, the Office Action references column 16, lines 4 – 13 of Hild. Applicants understand the cited passage to refer to a mobile phone indicating via an alert sound that email has been received by a mobile PC. Applicants respectfully assert that this cited passage, as well as Hild in its entirety, are silent as to the limitation of “automatically displaying a message indicating a user selection” as recited by Claims 1, 8 and 14. There is no mention in the cited passage of displaying or accepting a user selection. In fact, the same cited passage of Hild actually teaches away from the present invention by teaching that “it is then possible to browse incoming e-mail immediately....” (col. 16, lines 8-9, emphasis added) The

term “immediately” means “without delay.” The claimed limitations of “displaying a message” and a “user selection” action are such delays that Hild teaches away from. A capability to browse immediately requires the absence of the claimed limitations. Consequently, Applicants respectfully assert that Hild does not teach, disclose or suggest this limitation of Claims 1, 8 and 14.

For this reason, Applicants respectfully assert that Claims 1, 8 and 14 overcome the objection of record, and respectfully solicit allowance of this Claim.

Still referring to Independent Claims 1, 8 and 14, Applicants respectfully assert that Hild does not teach, disclose or suggest the claim limitation of “responsive to said user selection, ... said second electronic device automatically communicating” a “second information to said first electronic device wherein said second information is of said information category type” as recited by Claim 1 or “a second electronic business card” as recited by Claims 8 and 14.

With reference to this element of Claims 1, 8 and 14, the rejection references column 13, lines 12-33 of Hild. However, Applicants understand the cited passage to refer to broadcasts of service information. As is well known by those of ordinary skill in the art, there is a significant difference between broadcasting information and the directed communication, e.g., “communicating... to said first electronic device” of Claims 1, 8 and 14. For example, the sequence described in this passage of Hild can take place as described without device A receiving a responsive communication. If Hild does not disclose a responsive communication, Hild likewise cannot teach, disclose or suggest the claim limitation of “automatically communicating... to said first

electronic device." Further, as discussed previously, Hild actually teaches away from the Claim limitation of "responsive to said user selection...."

For these additional reasons, Applicants respectfully assert that Claims 1, 8 and 14 overcome the rejection of record, and respectfully solicit allowance of these Claims.

Claims 2 – 7 depend from Independent Claim 1. Applicants respectfully assert that Claims 2 – 7 overcome the rejections of record as they depend from an allowable base Claim, and respectfully solicit allowance of these Claims.

With reference to Claim 6, Applicants thank the Examiner for noting that Hild does not disclose the limitation of "wherein said information category type is calendar information" as recited by Claim 6. Applicants respectfully disagree with the statement that "it is inherent that most electronic device(s) such as PDA, computer etc. contains calendar information." By the use of the term "most," the rejection appears to contradict itself. The term "inherent" is generally understood to mean "existing as an essential constituent or characteristic; intrinsic." (The American Heritage Dictionary, Dell, 1983). As is well known by those of ordinary skill in the art, it is common for electronic devices, e.g., pagers, mobile phones, laptop computers, "car radio(s)" (Hild, col. 14, line 37), "public phone(s)" (Hild, col. 15, line 61), and the like, to not comprise calendar information. Consequently, if the rejection maintains that calendar information is inherent in electronic devices, then the Examiner is invited to locate and cite prior art to support this proposition.

For this additional reason, Applicants respectfully assert that Claim 6 overcomes the objections of record, and respectfully solicit allowance of this Claim.

Claims 9-13 depend from Independent Claim 8. Applicants respectfully assert that Claims 9-13 overcome the rejections of record as they depend from an allowable base Claim, and respectfully solicit allowance of these Claims.

With respect to Independent Claim 14, Applicants respectfully assert that Hild does not teach, suggest or disclose the limitation of “a memory coupled to said bus” as recited by Claim 14. Hild Figure 1 shows a memory coupled to a “meta data protocol resource manager 11.” Hild explains “that the MAC 12 and the resource manager 11 are logical constructs. They can be implemented on separate devices or incorporated into a program stored in memory.” (col. 10, lines 48-50) Clearly, if meta data protocol resource manager 11 can be “incorporated into a program stored in memory”, Figure 1 does not show “a memory coupled to said bus” as recited by Claim 14.

Further, Hild repeatedly explains its use of memory: “for storing information about its local services” (Claim 24 and col. 4, line 59); “means to store service information” (col. 12 lines 9-10) and “the service information is stored” (col. 12, lines 10-11). Applicants respectfully assert Hild’s memory “for storing information about its local services” does not teach, disclose or suggest “a memory... comprising instructions that implement a method...” as recited by Independent Claim 14.

For these additional reasons, Applicants respectfully assert that Claim 14 overcomes the objections of record, and respectfully solicit allowance of this Claim.

Claims 15-20 depend from Independent Claim 14. Applicants respectfully assert that Claims 15-20 overcome the rejections of record as they depend from an allowable base Claim, and respectfully solicit allowance of these Claims.

With respect to Claim 20, Applicants respectfully traverse the statement that “it is inherent that said display screen is a liquid crystal display screen since almost all the electronic devices have LCDs.” Many electronic devices do not comprise any display screen. Further, many electronic devices that do comprise display screens may use other display technologies that are well known. For example, vacuum tube florescent, plasma, field emission (FED or thin film cathode ray tube) and organic light emitting diode (OLED) display technologies are well known for use in such devices. Consequently, the use of LCD technology is not inherent in electronic devices.

For this additional reason, Applicants respectfully assert that Claim 20 overcomes the objections of record, and respectfully solicit allowance of this Claim.

35 U.S.C. § 103 (a) Rejections

Claims 13 and 19 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Hild et al. (US# 6,532,368 B1), (“Hild”). Applicants have

reviewed the cited reference and respectfully assert that the present invention as recited in Claims 13 and 19 overcomes Hild.

Applicants respectfully assert that Hild does not teach, suggest or disclose “allowing a user to select... accepting said first electronic business card and automatically transmitting said second electronic business card” as recited by Claims 13 and 19. With reference to these Claims, the rejection cites Hild column 12 lines 3-10 and column 15 lines 50-57. Applicants understand column 12 lines 3-10 to describe a broadcast transfer of service information. Hild is quite clear that service information is “meta data” and draws a clear distinction between meta data and user data such as an electronic business card. “Meta data’ refers to information about the protocols and/or services, as opposed to ‘user data,’ which may be useful in applications.” (col. 10 lines 33-37) Consequently, Applicants respectfully assert that this passage of Hild does not teach, suggest or disclose transmitting a business card.

With reference to Hild column 15 lines 50-57, Hild describes “an electronic business card exchanged during a handshake.” This passage does not teach, suggest or disclose “accepting said first electronic business card and automatically transmitting said second electronic business card” as recited by Claims 13 and 19. Rather, Hild refers to a single “card” using a singular article. This clearly does not teach, disclose or suggest the claimed limitation of a “second electronic business card.” Further, Hild in this passage and in its entirety is silent with respect to user selection. In fact, Hild actually teaches away from the present invention by teaching that “it is then possible to browse incoming e-mail immediately....” (col 16, lines 8-9, emphasis added) The term “immediately”

means "without delay." The claimed limitations of "displaying a message" and a "user selection" action are such delays that Hild teaches away from. A capability to browse immediately requires the absence of the claimed limitations.

Consequently, Hild fails to teach, disclose or suggest the limitations of Claims 13 and 19.

For this reason, Applicants respectfully assert that Claims 13 and 19 overcome the objections of record, and respectfully solicit allowance of these Claims.

CONCLUSION

Claims remaining in the present patent application are Claims 1 – 20.

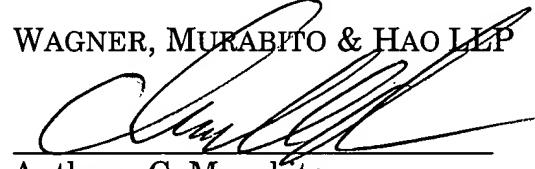
The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Please charge any additional fees or apply any credits to our PTO deposit account number: 23-0085.

Respectfully submitted,

WAGNER, MURABITO & HAO LLP

Date: 1/21/2004


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